

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,625	12/20/2000	Frank Bor-Her Chen	25164-67462	9358
28863 7590 11/23/2007 SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125			EXAMINER TSOY, ELENA	
			ART UNIT 1792	PAPER NUMBER
			NOTIFICATION DATE 11/23/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ssiplaw.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/742,625	Applicant(s) CHEN ET AL.	
	Examiner Elena Tsoy	Art Unit 1792	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended:
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

The Request for Reconsideration filed on November 6, 2007 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on September 6, 2007.

Response to Arguments

Applicants' arguments filed November 6, 2007 have been fully considered but they are not persuasive.

Claim Rejections Under 35 U.S.C. § 103(a)

A. Paragraph 3

Applicant respectfully traverses the rejection over DE 2224732 in combination with Cummings and Helmer et al. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. The Helmer reference fails to teach or suggest that his formaldehyde-free, rapid crosslinking composition could be useful as a primer for cellulosic or wood composites, or would be compatible with other components used in the manufacture of such composites, such as the presently claimed topcoat composition. A ground for this rejection appears to be that this is a simple process of replacing one "amino resin" for another. Applicants respectfully disagree with this conclusion, and it is Applicants' position that this rejection is neither supported by the teachings of the cited references nor by the general knowledge in the art. As noted on page 2 of the translation, DE '732 defines aminoplast resins as

urea, thiourea and melamine formaldehyde resins which is completely different from the formaldehyde free primer composition of present claim 37.

The Examiner respectfully disagrees with this argument. First of all, the aminoplast resin utilized in DE '732 is formaldehyde-free because formaldehyde is reacted with amine so that formaldehyde is no longer exists. Secondly, applicants attack against the DE '732 and Helmer references *individually* is improper because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Cummings teaches that amino resins curing fast at room temperature may be used for factory applied wood priming (See column 2, lines 14-20) or in traffic paints where virtually no waiting period is necessary for the paint to dry before traffic can pass (See column 2, lines 36) instead of heat curing or slow curing prior art compositions including prior art wood primers (See column 1, lines 56-66). Helmer et al teach a fast hardening aqueous (amino resin) coating composition can be utilized in applications where it is desirable to form a hard, smear-resistant, non-tracking surface very quickly after deposit of the coating under ambient conditions, *in particular*, as fast hardening aqueous traffic marking paint, which forms a hard, smear-resistant surface very soon after application under ambient conditions to a surface, such as a road way, and which allows the resumption of normal traffic with minimal interruption (See column 1, lines 11-20).

Therefore, one of ordinary skill in the art would have clear incentive to replace wood primer of DE '732 with room temperature fast curing wood/traffic resin of Cummings to achieve

the desired room temperature fast curing. Second, one of ordinary skill in the art would also have clear incentive to use Helmer traffic resin instead of wood/traffic resin of Cummings to achieve the desired hard, smear-resistant coating. Third, one of ordinary skill in the art would have reasonable expectation of compatibility of top coat layer of an aqueous amino-plastics resin and a dispersion of a self-cross-linking acrylic resin of DE '732 with an aqueous (amino resin) of Helmer. DE '732 teaches that the primer should be quick-hardening and contain reactive groups which react with self-crosslinking acrylic resin made from methacrylic acid, nitriles (See Translation, page 4, paragraph 2). The resin of Helmer contains the 95-99 % of the same self-crosslinking acrylic resin as that of DE '732. Furthermore, the Examiner takes official notice that it is a common knowledge in the art that polyimines, such as polyethyleneimine of Helmer (See column 16, lines 6-8), is reactive toward cellulose (i.e. toward hydroxyl groups), and is used as adhesive and anchoring agent for paper, and as a fixative agent for textile fibers, as evidenced by Hawley's Condensed Chemical Dictionary, ^{Twelfth}~~Thirteenth~~ Edition. Therefore, it would be reasonably expected that the acrylic resin of Helmer to be compatible with and would react with the acrylic resin of DE '732.

Therefore, in contrast to Applicants argument, a prima facie case of obviousness over DE 2224732 in combination with Cummings and Helmer et al has been established by the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

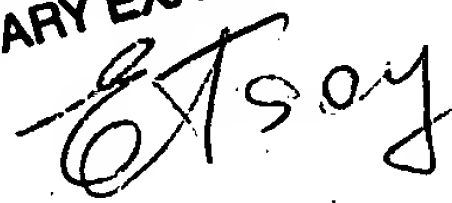
Application/Control Number:
09/742,625
Art Unit: 1792.

Page 5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELENA TSOY
PRIMARY EXAMINER



Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1792

November 9, 2007